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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,940	09/16/2003	Kimball C. Chen	64171.000002	2033

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[REDACTED] EXAMINER

BORISOV, IGOR N

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3639

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,940	CHEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,7,8,13,15,17,19,152,180-182,186,187,192,194,196,198 and 331 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,7,8,13,15,17,19,152,180-182,186,187,192,194,196,198 and 331 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



IGOR N. BORISSOV  
PRIMARY EXAMINER

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Applicant's election without traverse of claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 filed on 01/03/2006 is acknowledged. Claims 4-6, 9-12, 14, 16, 18, 20-151, 153-179, 183-185, 188-191, 193, 195, 197, 199-330 and 332-432 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Response to Amendment***

Amendment received on 01/03/2006 is acknowledged and entered. Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 have been elected without traverse, and are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following limitation: "where the at least one communication device enables the taking of at least one action having the effect of providing a change

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of one or more of resource-consumption and resource-production attributed to the at least one device of one or more devices", which is confusing:

First, it is not clear what a particular method step does the term *enables* actually contemplate. Second, it is not clear should the following limitation, which is not positively claimed, be given patentable weight: "having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device of one or more devices". Moreover, the *wherein* clause makes the claims confusing. MPEP 2106 (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses."

It appears that *wherein* clause merely states the result of the limitations in the claim and adds nothing to the patentability or substance of the claim.

Furthermore, the term "one or more" makes the claim confusing. For the purposes of examination Examiner understands the term "one or more" as "at least one".

Same reasoning is applied to the remaining claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr. et al. (US 5,544,036) in view of Woolard et al. (US 6,178,362).**

Brown, Jr. et al. (Brown) teaches a method and system for remote energy management and home automation system, said system including a central computer 24, a communication device (controller 14), and a communication link (transmitter 20), said method comprising:

**Claims 1 and 180,**

generating at least one informational message at a central computer related to one or more of resource-consumption by, resource-production by and control of at least one device (C. 4, L. 7-14; Figs. 1, 2);

transmitting the at least one informational message to at least one communication device (controller 14) (C. 4, L. 7-14)

where the at least one communication device (controller 14) enables the taking of at least one action having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device of one or more devices (C. 4, L. 7-18).

Brown does not explicitly teach that said central computer includes a server.

Woolard et al. (Woolard) teaches a method and system for remote energy management and home automation system, said system including a central server 60 (Fig. 3), which is configured to be in control communication with peripheral energy consuming devices D (C. 7, L. 37-38, 8-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that said central computer includes a server, as disclosed in Woolard, because it would advantageously allow to implement said system for multi-building facility, and interconnect various equipment for purposes of control and managing, as specifically stated in Woolard (C. 7, L. 32-35).

**Claims 2 and 181**, Brown teaches said method and system, wherein the at least one informational message comprises at least one control signal and wherein the at least one communication device comprises at least one interface unit, where the interface unit in communication with the one or more devices controls the at least one device in accordance with the at least one control signal, to take an action having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device (C. 4, L. 7-18).

**Claims 3 and 182**, Woolard teaches: receiving at least one command at the central server, wherein the at least one command is related to controlling at least one device and wherein the at least one informational message is generated based on the at least one command (C. 5, L. 47-51). The motivation to combine references would be to provide tools for developing strategies to reduce energy costs (Woolard; C. 5, L. 49).

**Claims 7 and 186**, Brown teaches said method and system, wherein the at least one informational message comprises an instruction directed to one or more of activating and deactivating the at least one device (C. 4, L. 7-14).

**Claims 8 and 187**, Brown teaches said method and system, wherein the at least one informational message comprises an instruction to adjust the operation of the at least one device wherein the instruction to adjust the operation is directed to one or more of state, use, one or more parameters, one or more set points, operating characteristics, duty cycle, control logic and scheduling of the at least one device (C. 4, L. 44-51).

**Claims 13, 14, 152 and 192, 194, 331**, Woolard teaches said method and system, wherein the at least one command is generated in accordance with a user profile (C. 6, L. 49-54)

**Claims 17 and 196**, Brown teaches said method and system, wherein the devices comprises one or more of an air-conditioner, boiler, motor starter and heater (C. 4, L. 63-66).

**Claims 19 and 198**, Brown teaches said method and system, wherein the interface unit causes the adjustments of one or more of resource-consumption and resource-production attributed to the at least one device in accordance with the at least one informational message (C. 4, L. 10-19, 47).

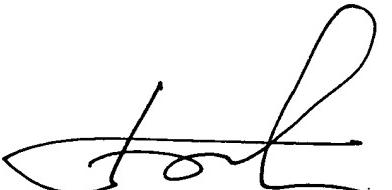
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
1/20/2005



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